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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,285	12/18/2000	Masaaki Nishikiori	1086.1128/JDH	2128

21171 7590 10/01/2004  
STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

CHARLES, DEBRA F

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/738,285

**Applicant(s)**

NISHIKIORI ET AL.

**Examiner**

Debra F. Charles

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2000.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2,5-11,13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 2, the phrase "and the like" and "such as" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Claims 13 and 14 use the term "and/or". This needs to be replaced with either the term "and" or the term "or". Both terms may not be used together. Claims 5-11 recite the limitation "the case " in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgida et al.(U.S.PAT. 5418943 A) and Corey et al.(U.S.PAT. 5987446 A).

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Re claim 1: Borgida disclose an information mediating apparatus for providing mediation services for the user(Abstract), comprising:

a mediating condition storing unit in which mediating condition list data describing specific mediating conditions necessary for mediation has been stored(claim 1, i.e. a database is a storage unit); and

a mediation service processing unit which reads out the mediating condition list data designated in correspondence to a user request from said mediating condition storing unit, (claims 1-13, col. 3, lines 50-60, col. 4, lines 15-55, col. 6, lines 15-67, col. 7, line 35-col. 8, line 65, col. 9, lines 15-65).

Borgida et al. disclose(s) the claimed invention except obtains specific conditions in said read-out mediating condition list data, another information storing unit merges said specific conditions, searches information which satisfies said merged conditions, and presents said information to the user. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claim 2: Borgida et al. disclose(s) the claimed invention except a user interface processing unit which forms display information such as mediation menu, mediation

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result, and the like and presents said display information to the user; and a logic processing unit which reads out said mediating condition list data, notifies a service providing server group of said read-out data, and forms mediation result information by matching with service information. However, in col. 6, line 35-col. 7, line 35, thereof, Corey et al. disclose(s) a display manager that coordinates a display of data aligned to show the matching result. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is to show the combined results on the display for the user.

Re claim 3: Borgida et al. disclose said mediation service processing unit designates and reads out specific mediating condition list data by analyzing an uncertain, rough, and abstract request from the user(col. 7, line 35-col. 9, line 65).

Re claim 4: Borgida et al. disclose(s) the claimed invention except said mediation service processing unit presents a selection menu in which request contents are divided into items to the user and designates and reads out the specific mediating condition list data in correspondence to selected menu items. However, in col. 6, line 35-col. 7, line 35, thereof, Corey et al. disclose(s) a display manager that coordinates a display of data aligned to show the matching result. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is to show the combined results on the display for the user formatted in a way the user prefers.

Re claim 5: Borgida et al. disclose(s) the claimed invention except said mediation service processing unit extracts corresponding personal information and merges with reference to a personal information storing unit. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claims 6 and 7: Borgida et al. disclose in the case where the corresponding personal information does not exist or does exist, said mediation service processing unit requests the user to input the personal information(col. 4, lines 55-65, claims 14, 15, and 17).

Re claim 8: Borgida et al. disclose wherein in the case where inquiring conditions to the user exist in the read-out mediating condition list data, said mediation service processing unit merges corresponding personal information as default values by referring to a personal information storing unit and, thereafter, requests the user to input the personal information while presenting said default values(col. 4, lines 55-65, claims 14, 15, and 17).

Re claim 9: Borgida et al. disclose(s) the claimed invention except in the case where calculating conditions exist in the read-out mediating condition list data, said mediation service processing unit executes a predetermined calculating expression on the basis of other mediating conditions and merges a result of said calculation. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claim 10: Borgida et al. disclose wherein said mediation service processing unit executes a predetermined calculating expression on the basis of conditions merged by referring to a personal information storing unit or by inquiring of the user and merges a result of said calculation into said calculating conditions(col. 3, lines 50-65, col. 4, lines 55-67, col. 9, line 65-col. 12, line 15) .

Re claim 11: Borgida et al. disclose in the case where the mediating condition list data read out from said mediating condition storing unit has a layer structure, said mediation service processing unit obtains necessary conditions by sequentially referring to the

personal information storing unit from a predetermined layer, by inquiring of the user, and/or by performing a calculating process and merges them(col. 3, lines 50-65, col. 4, lines 55-67, col. 9, line 65-col. 12, line 15).

Re claim 12: Borgida et al. disclose(s) the claimed invention except mediation service processing unit forms new mediating condition list data on the basis of a mediation result presented to the user and decided and stores it into said mediating condition storing unit. However, in col. 6, lines 35-65, Fig. 6C, thereof, Corey et al. disclose(s) combining two separate outputs into one output. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claims 13 and 14: Borgida disclose an information mediating method of providing mediation services for the user(Abstract),  
comprising the steps of:  
storing mediating condition list data describing specific mediating conditions necessary for mediation into a mediating condition storing unit(claim 1, i.e. a database is a storage unit, col. 3, lines 50-60, col. 4, lines 15-55, col. 6, lines 15-67, col. 7, line 35-col. 8, line 65, col. 9, lines 15-65).



Borgida et al. disclose(s) the claimed invention except reading out the mediating condition list data designated in correspondence to a user request from said mediating condition storing unit; obtaining specific conditions mediating condition list data by referring to another in said read-out information storing unit, by inquiring of the user, *and/or* by performing a calculating process based on predetermined conditions and merging said specific conditions; and searching information which satisfies said merged conditions and presenting said information to the user. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (703) 308-0505. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles  
Examiner  
Art Unit 3628

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HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600